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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,868	12/12/2001	Michael D. Hooven	HOOV 117	7290
26568	7590	09/07/2006	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			ROLLINS, ROSILAND STACIE	
		ART UNIT	PAPER NUMBER	
			3739	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/015,868	HOOVEN	
	Examiner Rosiland S. Rollins	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 August 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 50-58 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 50-58 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately disclose a tissue ablation apparatus as claimed that includes at least one of the conductive members defining an interior lumen and further comprises at least one temperature sensor associated with at least one jaw.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac (US H1745) in view of Burnside et al. (US 6071281).**

**Regarding claim 50,** in figure 5 Paraschac discloses a cardiac tissue ablation apparatus comprising first (116) and second jaws (117), the jaws being relatively

moveable between open and closed positions, respectively, receive and compress cardiac tissue there between; each jaw having a clamping surface (**see figure**) with a width and an elongated electrically conductive member (**118 & 119**) for jaws, the conductive members of the jaws being in face-to-face relation and connectible to a bipolar energy power source so as to be of opposite polarity when so connected for providing an electrical current through tissue between the jaws, the conductive members each having a tissue contacting portion (**as illustrated**), which portion has a width that is less than the width of the clamping surface of its associated jaw Paraschac teaches all of the limitations of the claims except the apparatus further comprising at least one temperature sensor associated with at least one jaw and disposed to sense the temperature of cardiac tissue at a location laterally spaced from the tissue contacting portions of the conductive members.

Burnside et al. discloses an electrosurgical device and teaches in column 32 lines 5-22 that it is old and well known in the art to associate at least one temperature sensor (299) with the treatment device at a location laterally spaced from the tissue contacting portions of the conductive members (250) as a means of controlling the energy delivered to the device. Therefore, it would have been obvious to add a temperature sensor to the Paraschac device as taught by Burnside et al., so that the temperature of the tissue or device can be measured as a means of monitoring and controlling the amount of energy delivered to device. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laterally space the temperature sensor from the tissue contacting portions of the

conductive members, since it has been held that rearranging parts of an invention involves only routine skill in the art.

**Regarding claim 52,** it would have been obvious to the artisan to dispose the temperature sensor proximal to the conductive member and electrically isolated it therefrom, since it has been held that rearranging parts of an invention involves only routine skill in the art.

**Regarding claim 54,** Paraschac teaches that each tissue contacting portion has a width that is less than or equal to about one-third the width of the associated clamping surface.

**Regarding claim 55,** it would have been obvious to the artisan to provide conductive members that are between approximately 3 to 8 cm in length and the portion of the conductive members is between approximately 0.12 to 0.6 mm in width, since it has been held that discovering the optimum size involves only routine skill in the art.

**Regarding claim 56,** Paraschac teaches that each conductive member is generally centrally located relative to the associated clamping surface.

**Regarding claim 58,** Paraschac discloses a portion of the clamping surface disposed on each side of the conductive member.

**Claims 50-56 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yates (US 5688270) in view of Burnside et al. (US 61071281).**

In figures 22-24 Yates disclose a cardiac tissue ablation apparatus comprising first (532) and second jaws (534), the jaws being relatively moveable between open and closed positions, respectively, receive and compress cardiac tissue there between;

each jaw having a clamping surface (**see figure**) with a width and an elongated electrically conductive member (**527a & 528b**) for jaws, the conductive members of the jaws being in face-to-face relation and connectible to a bipolar energy power source so as to be of opposite polarity when so connected for providing an electrical current through tissue between the jaws, the conductive members each having a tissue contacting portion (**as illustrated**), which portion has a width that is less than the width of the clamping surface of its associated jaw.

Yates teach all of the limitations of the claims except the apparatus further comprising at least one temperature sensor associated with at least one jaw and disposed to sense the temperature of cardiac tissue within the vicinity of the jaws. Burnside et al. discloses an electrosurgical device and teaches in column 32 lines 5-22 that it is old and well known in the art to associate at least one temperature sensor with the treatment device. Therefore, it would have been obvious to add a temperature sensor to the Yates device as taught by Burnside et al., so that the temperature of the tissue or device can be measured as a means of monitoring and controlling the amount of energy delivered to device. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laterally space the temperature sensor from the tissue contacting portions of the conductive members, since it has been held that rearranging parts of an invention involves only routine skill in the art.

***Claim Rejections - 35 USC § 103***

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac and Burnside et al. combined further in view of Francischelli (US 2003/0073991).**

Paraschac and Burnside et al. combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 2a-g, Francischelli disclose an electrosurgical device and teach that it is old and well known in the art to provide a conductive member (**102/104**) that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates and Burnside et al. combined further in view of Francischelli (US 2003/0073991).**

Yates and Burnside et al. combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 2a-g, Francischelli disclose an electrosurgical device and teach that it is old and well known in the art to provide a conductive member (**102/104**) that includes an interior lumen as a

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means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac and Burnside et al. combined further in view of Mulier (US 6096037).**

Paraschac and Burnside et al. combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 4 & 5, Mulier discloses an electrosurgical device and teach that it is old and well known in the art to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

**Claims 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yates and Burnside et al. combined further in view of Mulier (US 6096037).**

Paraschac and Burnside et al. combined teach all of the limitations of the claim except at least one of the conductive members defining an interior lumen. In figures 4 & 5, Mulier discloses an electrosurgical device and teach that it is old and well known in the art to provide a conductive member that includes an interior lumen as a means of

delivering conductive fluid along the length of the conductive member to facilitate energy transfer from the device to the tissue. Therefore, it would have been obvious to an artisan to provide a conductive member that includes an interior lumen as a means of delivering conductive fluid along the length of the conductive member, to facilitate energy transfer from the device to the tissue.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S. Rollins whose telephone number is (571) 272-4772. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rosiland S Rollins  
Primary Examiner  
Art Unit 3739